

11-17-03

AF/3711 \$

PATENT
930046-2002

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**



Applicant(s) : SHAW et al.
U.S. Serial No. : 09/883,002
Filed : June 15, 2001
For : **CONTROLLING A MULTIPLICITY OF
BASKETBALL ARENAS**
Examiner : William M. Pierce
Group Art Unit : 3711
Confirmation No. : 1475

745 Fifth Avenue
New York, NY 10151

EXPRESS MAIL

Mailing Label Number: EV 286858655US

Date of Deposit: November 14, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 CFR 1.10 on the date indicated above and is addressed to: Mail Stop Appeal Briefs-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Edward Nay

(Typed or printed name of person mailing paper or fee)

Edward Nay

(Signature of person mailing paper or fee)

RECEIVED
NOV 19 2003
TECHNOLOGY CENTER H3700

APPEAL BRIEF OF APPELLANTS

Mail Stop Appeal Briefs-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450.

Sir:

This is an Appeal from the Final Rejection by the Examiner dated January 10, 2003, which issued in the above-identified application, finally rejecting claims 1-18. A Notice of

11/18/2003 AWONDAF1 00000022 09883002

01 FC:2402
02 FC:2252

165.00 OP
210.00 OP

Appeal was filed on July 10, 2003. This Brief is submitted in triplicate as required by 37 C.F.R. §1.192(a) and is accompanied by the requisite fee set forth in 37 C.F.R. §1.17(f).

Appellants respectfully petition, pursuant to 37 C.F.R. §§ 1.36(a) 1.17(a), that the term for reply be extended for two months up to and including November 14, 2003 (as the Notice of Appeal was received at the PTO on July 14, 2003). A check in the amount of \$210.00 is enclosed in payment of the fee for a small entity. The Assistant Commissioner is authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-0320.

REAL PARTY IN INTEREST

The real party in interest is Jaypro Sports, Inc., with offices at 976 Hartford Turnpike, Waterford, Connecticut, 06385, to which Appellants have assigned all interest in this application.

RELATED APPEALS AND INTERFERENCES

Upon information and belief, the undersigned attorney does not believe that there is any appeal or interference that will directly affect, be directly affected by or have a bearing on the Board's decision in the pending appeal.

REQUEST FOR AN ORAL HEARING

An oral hearing is requested.

STATUS OF THE CLAIMS

The Application was filed with claims 1-17 on June 15, 2001, and assigned Application Serial No. 09/883,002. This application is a Continuation-in-Part application of Serial No. 09/413,664, filed on October 6, 1999 (abandoned).

In a first Office Action dated September 25, 2002, the Examiner rejected claims 4-17 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. The Examiner also rejected claims 1-17 under 35 U.S.C. §103 as allegedly being unpatentable over U.S. Patent 4,014,521 to Berman in view of U.S. Patent No. 3,983,553 to Kesling and further in view of matters allegedly considered old and well known.

In response to this first Office Action, Appellants filed an Amendment on December 18, 2003, amending claims 1, 4-6, 10-12 and 14-17; adding new claim 18; and arguing against the rejections.

The Examiner then issued a Final Office Action on January 10, 2003, rejecting claims 1-18. The Examiner rejected claims 4-18 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. The Examiner also rejected claims 1-18 under 35 U.S.C. §103 as allegedly being unpatentable over U.S. Patent 4,014,521 to Berman in view of U.S. Patent No. 3,983,553 to Kesling and further in view of matters allegedly considered old and well known.

A Notice of Appeal was filed by Appellants on July 10, 2003, from which this Appeal Brief is being filed.

Accordingly, the status of the claims may be summarized as follows:

Claims Allowed: None.
Claims Objected to: None.
Claims Rejected: 1-18.

STATUS OF THE AMENDMENTS

Appellants believe that all the submitted Amendments have been entered.

SUMMARY OF THE INVENTION

The present invention is directed to a sports enclosure system. The system is defined by an interior chamber divided into a multiplicity of play arenas. The arenas have, *inter alia*, a means for moving a basketball goal operating at a first voltage, relays for controlling said means, said relays being responsive to relay control signals at a second voltage, said second voltage being lower than said first voltage; and central control means for separately operating each means for moving, and generating said relay control signals.

The present invention is also directed to sports enclosure system having a central control means with a numeric or alphanumeric keypad adapted to be programmed with a security code; a central control means in the form of a touch screen which may be, for example, customized to depict virtual animation; and means for controlling auxiliary gymnasium equipment.

ISSUES PRESENTED

- (I) Whether claims 4-17 are indefinite under 35 U.S.C. §112, second paragraph.
- (II) Whether claims 1-18 are unpatentable under 35 U.S.C. §103 over U.S. Patent 4,014,521 to Berman in view of U.S. Patent No. 3,983,553 to Kesling and further in view of matters allegedly considered "old and well known."

GROUPING OF CLAIMS

For purposes of this appeal, claims 1-18 constitute one group and stand or fall together.

ARGUMENTS

I. Claims 4-17 Were Improperly Rejected as Indefinite Under 35 U.S.C. §112, Second Paragraph

Appellants disagree with the Examiner's allegations that claims 5-7, 16 and 17; and claims 10-12, 14 and 15 are indefinite. A claim is definite if the scope of the subject matter embraced by a claim is clear and if the applicant has not otherwise indicated that he intends the claims to be of a different scope. *In re Borkowski*, 164 U.S.P.Q. 642 (C.C.P.A. 1970). The "distinctly claim" requirement of 35 USC § 112, second paragraph, means that the claims must have a clear and definite meaning when construed in light of the complete patent document. *Standard Oil Co. v. American Cyanamid Co.*, 227 U.S.P.Q. 293 (Fed. Cir. 1985). The test of definiteness is whether one skilled in the art would understand the scope of the claim when read in light of the specification. *Morton Int. Inc. v. Cardinal Chem. Co.*, 28 U.S.P.Q.2d 1190 (Fed. Cir. 1993). And the degree of precision necessary is a function of the subject matter claimed. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 94-95 (Fed. Cir. 1986). Indeed, the Federal Circuit noted in *Hybritech* that:

'[I]f the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more' [and] the claims are clearly definite.

Id. at 94 (citing to *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 225 U.S.P.Q. 634, 641 (Fed. Cir. 1985)) (emphasis added).

Against this background, the claims are definite. Claims 5-7, 16 and 17 contain positive recitations of additional embodiments of the instant invention. For example, claim 5 defines a

control means further comprising means for activating control lines; claim 6 defines a control means further comprising switch means; claim 7 further defines the means for moving to be responsive to the power lines; claim 16 provides for an apparatus that further comprises means for moving height adjusters; and claim 17 provides for an apparatus that further comprises means for controlling auxiliary gymnasium equipment.

Further, claims 10-12, 14 and 15 are not simply narrative. The claims may be read as providing a means for, *inter alia*, reducing cost, reducing complexity, increasing safety and consolidating electrical lines.

As the instant claims, read in light of the specification, apprise a skilled artisan of both the utilization and scope of the invention, and as the language is as precise as the subject matter permits, the instant claims are definite. A contrary conclusion, as posited by the Office Action, would not only be against public policy, but would also be impermissible as a matter of law. *See Hybritech*, 231 U.S.P.Q. at 95 (“As a matter of law, no court can demand more.”).

Consequently, the Board is asked to allow the rejected claims.

II. Claims 1-18 Were Improperly Rejected as Unpatentable Under 35 U.S.C. §103(a)

Appellants disagree with the Examiner’s characterization of the instant invention as being directed to simply “game courts, game equipment and areas having multiple game courts and game equipment use therein” (Final Office Action, at 2); or that the invention is mere automation. The Examiner has failed to appreciate the depth of Appellants’ invention. More specifically, the instant invention provides for a sports enclosure apparatus defining an interior chamber. The chamber, in turn, is divided into a multiplicity of play arenas, wherein **each arena** has, for example, relays and a central control means. The relays control the means for moving at

a first voltage, and the relays are responsive to relay control signals at a second voltage, wherein the second voltage being lower than said first voltage. The central control means separately operates each means for moving and generates the relay control signals.

The instantly claimed invention also provides for, *inter alia*:

- a numeric or alphanumeric keypad adapted to be programmed to require a security code for use;
- a central control means in the form of a touch screen which may be, for example, customized to depict virtual animation; and
- means for controlling auxiliary gymnasium equipment.

The instant invention also exhibits unexpected results and superiority over the art and, thus, rebuts any holding of *prima facie* obviousness. More specifically, the instant invention is operated with reduced cost, reduced complexity, increased safety, reduced insulation requirements, and with a consolidation of electrical lines. Indeed, one of the superior benefits of the instant invention is the cost savings that result from running low voltage control lines down to the control device, such as a key pad.

Appellants take exception to the Examiner's *nothing-is-patentable-because-everything-is-known* spin on obviousness as a basis for rendering Appellants' invention unpatentable. This is impermissible and unjustified. According to the Board of Patent Appeals and Interferences in *Ex parte Obukowicz*, 27 U.S.P.Q. 2d 1063, 1065 (B.P.A.I. 1992) (with emphasis):

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art *would lead* that individual to combine the relevant teachings of the references. *In re Fine*, 837

F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Indeed, the teachings of references can be combined *only* if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 723 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

Indeed, it is well established that "there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Uniroyal v. Rudkin-Wiley*, 5 USPQ 2d 1434, 1438 (Fed. Cir. 1980).

Further, as stated by the Court in *In re Fritch*, 23 USPQ 2d 1788, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification."

Against this background, the rejection of claims 1-18 as being unpatentable over Berman and Kesling is meritless. The Examiner has not established a *prima facie* case by failing to provide the necessary teaching, suggestion, incentive or motivation for modifying the cited art in order to arrive at the instant invention.

Berman simply relates to and claims divider nets for use between tennis courts. The divider nets have replaceable panels so that when a tennis player collides into the net, the damaged panel can be removed and replaced, thereby increasing the useful life of the net. Nowhere, however, is there any disclosure, teaching, suggestion or motivational recitation that would lead a skilled artisan to practice Appellants' invention. In other words, Berman is devoid of any teaching of a sports enclosure defining an interior chamber, said chamber being divided into a multiplicity of play arenas, said arena having, *inter alia*, a means for moving a basketball goal operating at a first voltage, relays for controlling said means, said relays being responsive to relay control signals at a second voltage, said second voltage being lower than said first voltage;

and central control means for separately operating each means for moving, and generating said relay control signals.

Berman also fails to teach or suggest a numeric or alphanumeric keypad adapted to be programmed with a security code; a central control means in the form of a touch screen which may be, for example, customized to depict virtual animation; and means for controlling auxiliary gymnasium equipment.

Kesling does not remedy the inherent deficiencies in Berman. Kesling simply relates to a sound-emitting touch-pad for a domestic electrical appliance (like as a dishwasher). Contrary to the allegations in the Office Action, however, nowhere in Kesling is there any teaching, suggestion or motivational recitation that would lead a skilled artisan to practice the instantly claimed invention. Neither is there any suggestion or motivational recitation in Kesling that would lead a skilled artisan to combine its teachings with that of Berman, or vice versa. The only teaching, suggestion or motivation that would lead a skilled artisan to practice Appellants invention is found in the instant specification, and that is not the standard by which to base an obviousness rejection.¹

Indeed, following the Examiner's reasoning, the combination of Berman and Kesling would lead a skilled artisan to practice a tennis court net with a dishwasher's touch screen attached thereon. Appellants' invention is clearly patentably distinguishable from such a combination.

Appellants continue to believe that the Examiner erred by relying on *In re Venner* for the draconian allegation that automating a manual activity has been held to be obvious and not

¹ Appellants appreciate the Examiner's Phillips head screw/flathead screw analogy on page 3 of the Final Office Action. The Examiner, however, is comparing apples to apples, as these are both examples of screws. The cited art and the instant invention are, by contrast, far more disparate. Suffice it to say that a child's tricycle does not render a luxury automobile unpatentable, regardless of what is "well-known" in the art.

considered a patentable advance. The Federal Circuit was very clear that “reliance on per se rules of obviousness is legally incorrect and must cease.” *In re Ochai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995).

Contrary to the Examiner’s allegations, *Ex parte Brouillet* 2001 WL 1339914 (B.P.A.I. April 12, 2001) is on point and distinguishes *Venner* from the instant case. In *Venner*, all the limitations of the claims were disclosed in the applied references. Like *Brouillet*, that is not so here, as there is no suggestion in any of the cited documents for, *inter alia*, a means for moving a basketball goal operating at a first voltage, relays for controlling said means, said relays being responsive to relay control signals at a second voltage, said second voltage being lower than said first voltage; and central control means for separately operating each means for moving, and generating said relay control signals. Further, the Examiner has not established that manually adjusting the basketball goals accomplishes the same result as automatic adjustment utilizing a central control means. Manual adjustment, for example, does not prevent unauthorized adjustments. By contrast, the instantly claimed invention utilizes a keypad which is adapted to receive a security code in order to maintain security. Thus, according to the Board in the analogous *Brouillet* case, the Examiner “has not carried the burden of establishing a *prima facie* case of obviousness.” *Brouillet*, 2001 WL 1339914 at *3.

Further, it is error for the Examiner to merely assert that a claimed element, not found in the cited art, is “well known in the art” if no reasons or authorities are relied upon for support. See *In re Pardo and Landau*, 214 U.S.P.Q. 673 (C.C.P.A. 1982); see also *In re Ahlert*, 165 U.S.P.Q. 418, 420-21 (C.C.P.A. 1970). In view of *In re Pardo and Landau* and *In re Ahlert*, it is improper for the Examiner to fail to cite a reference which specifically describes the instantly claimed sports enclosure having, *inter alia*, a defined playing zone, a basketball goal, means for

moving the basketball goal, relays for controlling the means for moving the basketball goal, and central control means.

It is well-settled that "obvious to try" is not the standard upon which an obviousness rejection should be based. *See In re Fine*. And as "obvious to try" would be the only standard that would lend the Section 103 rejection any viability, the rejection must fail as a matter of law. Therefore, applying the law to the instant facts, the rejection is fatally defective and should be removed.

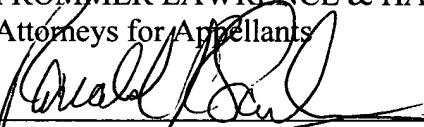
Accordingly, for at least the reasons described above, the documents cited by the Examiner fail to render claims 1-18 unpatentable under 35 U.S.C. §103(a). Therefore, the rejected claims should be allowed.

CONCLUSION

For the reasons discussed in this brief, claims 1-18 are patentable. It is, therefore, respectfully submitted that the Examiner erred in rejecting claims 1-18, and a reversal by the Board is solicited.

Respectfully submitted,

FROMMER LAWRENCE & HAUG, LLP
Attorneys for Appellants

By: 

Ronald R. Santucci
Reg. No. 28,998
Samuel H. Megerditchian
Reg. No. 45,678
Tel (212) 588-0800
Fax (212) 588-0500

APPENDIX

CLAIMS ON APPEAL

1. (Amended) A sports enclosure apparatus defining an interior chamber, said chamber being divided into a multiplicity of play arenas, each arena comprising:
 - a defined playing zone;
 - a basketball goal on one side of each play zone, said basketball goal being movable to a non-playing overhead position and to a playing lower position;
 - means for moving the basketball goal from the non-playing overhead position to the playing lower position and for moving the basketball goal from the playing lower position to the non-playing overhead position, said means for moving operating at a first voltage;
 - relays for controlling said means for moving at said first voltage, said relays being responsive to relay control signals at a second voltage, said second voltage being lower than said first voltage; and
 - a central control means for separately operating each means for moving, and generating said relay control signals.

2. (Original) The apparatus of claim 1 further including means for moving curtains between said play zones.

3. (Original) The apparatus of claim 2 wherein said central control means includes a numeric or alphanumeric keypad.

4. (Amended) The apparatus of claim 3, wherein said numeric or alphanumeric keypad further comprises keys for choosing from said means for moving the basketball goal and said means for moving curtains.

5. (Amended) The apparatus of claim 4, wherein said central control means comprises means for activating a plurality of control lines.

6. (Amended) The apparatus of claim 5, further comprising switch means responsive to said control lines for activating a number of power lines.

7. (Original) The apparatus of claim 6 wherein each of said means for moving is responsive to said power lines.

8. (Original) The apparatus of claim 3 wherein said numeric or alphanumeric keypad can be programmed to require a security code for use.

9. (Original) The apparatus of claim 3 wherein said numeric or alphanumeric keypad can be reprogrammed.

10. (Amended) The apparatus of claim 1, wherein said apparatus is adapted to be installed with reduced cost, reduced complexity and increased safety.

11. (Amended) The apparatus of claim 1, wherein said apparatus is adapted to be installed with reduced installation costs and insulation requirements.

12. (Amended) The apparatus of claim 1, wherein said apparatus is adapted to be installed with a consolidation of electrical lines.

13. (Original) The apparatus of claim 1 wherein said central control means is a touch screen.

14. (Amended) The apparatus of claim 13, wherein said touch screen is adapted to be customized.

15. (Amended) The apparatus of claim 13, wherein said touch screen is adapted to depict virtual animation.

16. (Amended) The apparatus of claim 1, further comprising means for moving a number of height adjusters.

17. (Amended) The apparatus of claim 1, further comprising means for controlling an auxiliary gymnasium equipment.

18. (New) A sports enclosure apparatus defining an interior chamber, said chamber being divided into a multiplicity of play arenas, each arena comprising:

a defined playing zone;

a basketball goal on one side of each play zone, said basketball goal being movable to a non-playing overhead position and to a playing lower position;

means for moving the basketball goal from the non-playing overhead position to the playing lower position and for moving the basketball goal from the playing lower position to the non-playing overhead position;

relays for controlling said means for moving by a control line, said relays being responsive to relay control signals; and

a central control means for separately operating each means for moving, and generating said relay control signals for separately activating a plurality of control lines.